



REMARKS

Applicants submit this Response in reply to the Office Action mailed June 14, 2006.

The Examiner has rejected claims 66-94 on the grounds of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-4 of Liljestrand et al. (U.S. Patent No. 6,200,531 B1) in view of Ghaed et al. (U.S. Patent No. 5,466,416 A). The Examiner alleges that Liljestrand teaches an apparatus with many of the same limitations as are presently claimed. The Examiner further argues that Ghaed teaches "the use of a fluid handling system that has a fluid heater system," (Office Action at p. 3) and that Liljestrand teaches "that the electrochemiluminescence process occurs at the working electrode 140 site when testing assay samples." (*Id.*)

An obviousness-type double patenting rejection is analogous to an obviousness rejection based on 35 U.S.C. § 103, except that the patent principally underlying the double patenting rejection is not considered prior art. See M.P.E.P. 804(II)(B)(1). For this reason, an obviousness-type double patenting rejection is only appropriate if the **claimed** subject matter of an application claim is not patentably distinct from the **claimed** subject matter in a commonly owned patent. *Id.* According to the M.P.E.P. and case law, the analysis required to support an obviousness-type double patenting rejection parallels the guidelines for a Section 103 obviousness rejection and the following *Graham v. John Deere Co.* inquiries must be employed:

(A) Determine the scope and content of a patent **claim** and the prior art relative to a **claim** in the application at issue;

- (B) Determine the differences between the scope and content of the patent claim and the prior art as determined in (A) and the claim in the application at issue;
- (C) Determine the level of ordinary skill in the pertinent art; and
- (D) Evaluate any objective indicia of nonobviousness.

Id. (emphasis added).

M.P.E.P. §804(II)(B)(1) further requires that

[a]ny obviousness-type double patenting rejection should make clear:

- (A) The differences between the invention defined by the conflicting claims—a **claim** in the patent compared to a **claim** in the application; and
- (B) The reasons why a person of ordinary skill in the art would conclude that the invention defined in the claim in issue is an obvious variation of the invention defined in a claim in the patent.

(emphasis added).

In considering the latter, the disclosure of the patent may not be used as prior art. M.P.E.P. § 804(II)(B)(1). The inquiry is limited to the differences in the elements recited in the application patent claims, without resort to the patent disclosure. Also, a patent claim, or an element of a claim, cannot be relied on for what it discloses--only for what the claim as a whole defines. See *General Foods Corp. v. Studiengesellschaft Kohle mbH*, 23 U.S.P.Q. 2d 1839, 1845 (Fed. Cir. 1992) (In a double patenting rejection the comparison is made "only with what invention is *claimed* in the earlier patent, paying careful attention to the rules of claim interpretation to determine what invention a claim *defines* and not looking to the claim for anything that happens to be mentioned in it as though it were a prior art reference.") (emphasis in original).

The Examiner did not present such an analysis in rejecting claims 66-94 of this application. Indeed, contrary to the guidance of *General Foods*, rather than comparing the application claims to the patent claims for what they define, the Examiner appears to look to the patent claims for what they allegedly teach as though the claims were a prior art reference. Such an analysis is improper under the case law and the M.P.E.P.

As also set forth above, M.P.E.P. § 804(II)(B)(1) requires obviousness-type double patenting rejections to make clear "the differences between the inventions defined by the conflicting claims . . . and . . . the reasons why a person of ordinary skill in the art would conclude the invention defined in the claim in issue is an obvious variation of the defined in a claim of the patent." (Emphasis added.) The Examiner has not made clear the differences between the inventions defined by the conflicting claims, nor has the Examiner provided any reasons as to why one of ordinary skill in the art would find those differences to be obvious variants of one another.

Indeed, the Examiner stated that "Liljestrand does teach that the electrochemiluminescence process occurs at the working electrode 140 site when testing assay samples (see, e.g., 14, lines 41-64)." (Office Action at p. 3). This is impermissible argument, however, because the M.P.E.P. and case law require obviousness-type double patenting rejections to compare only the **claimed** subject matter of an application claim to the **claimed** subject matter in a commonly owned patent, as explained above. The Examiner here attempts to rely on the specification. The M.P.E.P, however, makes clear that one can only rely on the specification in an obviousness-type double patenting rejection for very particular reasons. The specification "can be used as a dictionary to learn the meaning of a term in the patent

claim” or “the portions of the specification which provide support for the patent claims may also be examined and considered when addressing the issue of whether a claim in the application defines an obvious variation of an invention claimed in the patent”. See M.P.E.P 804(II)(B)(1) (citations omitted).

In this case, the relied-upon portion of the specification is not necessary to support the apparatus claims in Liljestrand. The fact that the ECL process occurs at the working electrode is not necessary to construct the claimed apparatus. Nothing in the claims of Liljestrand relate to temperature. As such, this portion of the specification is not required to provide support for the patent claims, nor is it necessary to address an obvious variant of an invention or to act as a dictionary for the meaning of a term in the patent claim. Therefore, the Examiner is attempting to use the specification improperly in constructing this double patenting rejection.

Moreover, the Examiner has not shown that claims 66-94 of the present application are not patently distinct from the claims of the commonly owned patent. For example, claims 66-94 of the present application require a heater thermally coupled to the working electrode, while the claims of Liljestrand do not. The Examiner appears to rely on Ghaed for the teaching of a heater. (See Office Action at p. 3). Ghaed, however, does not teach the heater disclosed in the present invention. In Ghaed, Figure 10 illustrates the heater block 570 separated from the flow cell 50 by the outlet line 802. (See Ghaed Fig. 10). The present application eliminates this separation, requiring that the heater be thermally coupled to the electrode. See Specification at 29, 31. Therefore, the Examiner has not shown that a person of ordinary skill in the art

would not conclude that the methods defined in the claims of the present application are an obvious variant of the device defined in the claims of Liljestrand in view of Ghaed.

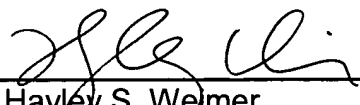
For the above reasons, a *prima facie* case has not been made to support the double patenting rejection. Applicants respectfully submit that the double patenting rejection of claims 66-94 is improper and should be withdrawn.

Please grant any extensions of time required to enter this Response and charge any required fees not otherwise provided for to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: September 14, 2006

By: 
Hayley S. Welmer
Reg. No. 57,009